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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,083	03/01/2002	Ian Richard Joseph Bates	041618-0060	9636

22204 7590 03/22/2007
NIXON PEABODY, LLP
401 9TH STREET, NW
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WASHINGTON, DC 20004-2128

EXAMINER

KING, BRADLEY T

ART UNIT	PAPER NUMBER
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3683

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/980,083

Applicant(s)

BATES, IAN RICHARD JOSEPH

Examiner

Bradley T. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02-07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-5 and 10-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 4 and 10 have been amended to include the higher target pressure band to exceed the normal target pressure band by 8-10%. The original disclosure only supports the 8-10% difference in the target pressures. The original disclosure appears to be silent as to the difference of the bands.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 8, and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/17493.

WO 98/17493 discloses all the limitations of the instant claims including: a control system having one or more inputs indicative of a vehicle operating state, and an output for determining whether a compressor is on-load or of-load, the system further including target means to calculate a target pressure band (from P min to P_{int}, or from P_{min} to P_{max}) for a reservoir downstream of said compressor, said output being responsive to said target means, wherein the target pressure band changes within the throttle off mode (either p_{max} or p_{int} is selected depending on braking probability at step 42) and is higher (up to P_{max}, box 20) during throttle-off modes than throttle-on modes (limited to P_{min}). Note the selection of the target pressure is carried out in real time.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/17493.

Regarding claim 4, WO 98/17493 discloses all the limitations of the instant claim with exception to the higher target pressure being 8-10% higher. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine the appropriate target pressures of WO 98/17493 through routine calculation and/or experimentation to determine the optimum values for a particular compressed air system, thereby enhancing the performance of the system. Also note, *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claim 5, note p max.

Regarding claims 9-10, note page 5, lines 5-15.

Regarding claim 11, note p max.

Response to Arguments

Applicant's arguments filed 2/28/2007 have been fully considered but they are not persuasive.

Regarding the "target means to calculate", it is maintained that the selection of different limit values disclosed by the reference reads upon the recited "target means to calculate a target pressure" as broadly defined by the claims. Note the system determines or ascertains which values to use based on the detected operating states of the system (sensed vehicle conditions). The selection of the target pressure is carried

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out in real time. Also note limitations are read in light of the disclosure. The instant disclosure fails to elaborate on any calculation. Instead, selection of predetermined levels (such as done by the prior art) is implied. Note page five of the instant disclosure states; "Next the engine is started, and is idling. The pressure target is immediately set at the normal level; in this embodiment just above 9 bar" and "Next, in the overrun mode, the illustrated target pressure is increased to nearly 10 bar. The higher target pressure is set according to system requirements, and may be more or less than 10 bar." Page 6 describes "In the next idling mode the pressure target reduces again to the normal level". It is not clear how the "calculation" of the instant disclosure differs from the mode of operation of WO 98/17493. It is maintained that the rejections are proper.

Regarding the recitation of a "pressure band", note that WO 98/17493 discloses a pressure band which changes from ($P_{min} \rightarrow P_{int}$) to ($P_{min} \rightarrow P_{max}$). Also note the arguments above regarding the degree of calculation supported by the instant disclosure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley T. King whose telephone number is (571) 272-7117. The examiner can normally be reached on 11:00-7:30 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on (571) 272-6786. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BTK


BRADLEY KING
PATENT EXAMINER